

REMARKS

The Office Action dated February 1, 2008, has been received and carefully considered. Claims 1-18 are pending in the present patent application. In this response, claims 2, 3, 5-8, 10, 11, 14, and 15 have been amended. No new matter has been introduced by this Amendment. Entry of the amendments to claims 2, 3, 5-8, 10, 11, 14, and 15 is respectfully requested. Reconsideration of the current rejections in the present application is also respectfully requested based on the following remarks.

I. THE NON-STATUTORY SUBJECT MATTER REJECTION OF CLAIM 5

On page 2 of the Office Action, claim 5 is currently rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. This rejection is hereby respectfully traversed.

The Examiner asserts that claim 5 is not limited to tangible embodiments. However, there is no such requirement on patentable subject matter as long as the claimed invention as a whole accomplishes a practical application. That is, it must produce a “useful, concrete and tangible result.” State Street Bank & Trust Co. v. Signature Financial Group Inc., 149 F.3d 1368, 1373 (Fed. Cir. 1998). Furthermore, Applicants direct the Examiner to the case law set forth in In re Beauregard, 53 F.3d 1583, (Fed. Cir. 1995), Ex parte Lundgren, 76 USPQ2d 1385 (Bd. Pat. App. & Int. 2005), and others, which clearly provide a patentable subject matter basis for claim 5. At this point it should be noted that claim 5 does recite tangible embodiments. However, in order to forward the prosecution of the present patent application, Applicant has amended claim 5 in accordance with the Examiner’s suggestion. Thus, Applicant respectfully submits that the amended claim 5 recites a tangible embodiment.

In view of the foregoing, it is respectfully requested that the aforementioned non-statutory subject matter rejection of claim 5 be withdrawn.

II. THE ANTICIPATION REJECTION OF CLAIMS 1, 3-5, 7-9, 11-13, 15 & 16

On page 3 of the Office Action, claims 1, 3-5, 7-9, 11-13, 15, and 16 are currently rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent Application Publication No. 2002/0087364 to Lerner *et al.* (“Lerner”). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. In re King, 801 F.2d 1324, 1326 (Fed. Cir. 1986). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. Celeritas Tech., Ltd., v. Rockwell Int’l Corp., 150 F.3d 1354, 1361 (Fed. Cir. 1998). “In addition, the prior art reference must be enabling.” Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1479 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In re Donohue, 766 F.2d 531, 533 (Fed. Cir. 1985). Such possession is effected only if one of ordinary skill in the art could have combined the disclosure in the prior art reference with his/her own knowledge to make the claimed invention. Id.

Regarding claim 1, the Examiner asserts that Lerner discloses the claimed invention. Specifically, the Examiner asserts that Lerner discloses “identifying medication information provided by an applicant,” as presently claimed. Applicant respectfully disagrees. In contrast, Lerner merely discloses a server system prompts the user for responses to “current medical conditions and lifestyle (e.g., occupation, participation in dangerous recreational activities, use of

tobacco or other substances (e.g., drugs, cigars, cigarettes, pipes, etc.).” *See*, e.g., paragraph [0022]. Although, Lerner mentions the server system prompts the user for response to use of drugs, the drugs of Lerner is not the “medication information,” as presently claimed. The drugs of Lerner is directed to tobacco, cigars, cigarettes, and pipes. In contrast, the “medication information,” as presently claimed is directed to medication taken by the Applicant and the medication information may include “the names of the medications, the amount taken per dosage, the frequency of dosage, the time period for which each medication is taken, etc.” *See*, e.g., Specification paragraph [0026]. Therefore, Applicant respectfully submits that Lerner at best discloses identifying use of tobacco or tobacco related substances by an applicant and fails to disclose, “identifying medication information provided by an applicant,” as presently claimed.

Also, the Examiner asserts that Lerner discloses “assessing a consistency between the medication information and the medical condition information, as presently claimed. In particular, the Examiner alleges that a server system of Lerner quantitatively assesses and analyzes the information to determine an eligibility score or value with respect to the insurability issues of interest as disclosing “assessing a consistency between the medication information and the medical condition information,” as presently claimed. Applicant respectfully disagrees. Applicant submits that Lerner discloses the server system employs an algorithm based on insurer underwriting criteria to evaluate the medical information retrieved from databases 8 and the information provided by the potential customer and produce the underwriting score or value. *See*, e.g., paragraph [0024]. Moreover, Lerner discloses a total risk factor or eligibility score is calculated by adding the individual assessment values assigned to the potential customer after review of the medical and application information. *See*, e.g., paragraph [0024]. Nowhere does Lerner disclose that the algorithm used by the server system “assessing a consistency between

the medication information and the medical condition information,” as presently claimed. Furthermore, Lerner provides example of underwriting criteria may assign points based on medical test results or other information. By way of example, low blood pressure may be assigned one point, moderate blood pressure may be assigned three points and high blood pressure may be assigned five points. *See, e.g.,* paragraph [0024]. Therefore, Applicant respectfully submits that Lerner merely discloses a underwriting score and fails to disclose “assessing a consistency between the medication information and the medical condition information,” as presently claimed.

Further, the Examiner asserts that Lerner discloses “making at least one insurance underwriting decision based on the consistency between the medication information and the medical condition information,” as presently claimed. Applicant respectfully disagrees. Instead, Lerner merely discloses a total risk factor or eligibility score represents a comprehensive quantified assessment of the potential customer insurability, and is used to make decisions on whether or not to underwrite a life insurance policy and to determine the price of the policy. *See, e.g.,* paragraph [0024]. Therefore, Lerner merely discloses making an insurance underwriting decision based on the total risk factor or eligibility score and fails to disclose “making at least one insurance underwriting decision based on the consistency between the medical information and the medical condition information,” as presently claimed.

Regarding claims 3 and 4, these claims are dependent upon independent claim 1. Thus, since independent claim 1 should be allowable as discussed above, claims 3 and 4 should also be allowable at least by virtue of their dependency on independent claim 1. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

Regarding claims 5, 9, and 13, these claims recite subject matter related to claim 1. Thus, the arguments set forth above with respect to claim 1 are equally applicable to claims 5, 9, and 13. Accordingly, it is respectfully submitted that claims 5, 9, and 13 are allowable over Lerner for the same reasons as set forth above with respect to claim 1.

Regarding claims 7, 8, 11, 12, 15, and 16, these claims are dependent upon independent claims 5, 9, and 13. Thus, since independent claims 5, 9, and 13 should be allowable as discussed above, claims 7, 8, 11, 12, 15, and 16 should also be allowable at least by virtue of their dependency on independent claims 5, 9, and 13. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection of claims 1, 3-5, 7-9, 11-13, 15, and 16 be withdrawn.

III. THE OBVIOUSNESS REJECTION OF CLAIMS 2, 6, 10, 14, 17, & 18

On page 6 of the Office Action, claims 2, 6, 10, 14, 17, and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0087364 to Lerner *et al.* ("Lerner") in view of U.S. Patent Application Publication No. 2001/0032099 to Joao ("Joao"). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a prima facie case of obviousness. In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). There are four separate factual inquiries to consider in making an obviousness determination: (1) the scope and content of the prior art; (2) the level of ordinary skill in the field of the invention; (3) the differences between the claimed invention and the prior art; and (4) the existence of any objective evidence,

or “secondary considerations,” of non-obviousness. Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966); see also KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007). An “expansive and flexible approach” should be applied when determining obviousness based on a combination of prior art references. KSR, 127 S. Ct. at 1739. However, a claimed invention combining multiple known elements is not rendered obvious simply because each element was known independently in the prior art. Id. at 1741. Rather, there must still be some “reason that would have prompted” a person of ordinary skill in the art to combine the elements in the specific way that he or she did. Id.; In re Icon Health & Fitness, Inc., 496 F.3d 1374, 1380 (Fed. Cir. 2007). Also, modification of a prior art reference may be obvious only if there exists a reason that would have prompted a person of ordinary skill to make the change. KSR, 127 S. Ct. at 1740-41.

Regarding claim 17, this claim recites subject matter related to claim 1. Thus, the arguments set forth above with respect to claim 1 are equally applicable to claim 17. Accordingly, it is respectfully submitted that claim 17 is allowable over Lerner in view of Joao for the same reasons as set forth above with respect to claim 1.

It is respectfully submitted that the aforementioned obviousness rejection of claims 2, 6, 10, 14, and 18 has become moot in view of the deficiencies of the primary reference (i.e., Lerner) as discussed above with respect to independent claims 1, 5, 9, 13, and 17. That is, claims 2, 6, 10, 14, and 18 are dependent upon independent claims 1, 5, 9, 13, and 17 and thus inherently incorporate all of the limitations of independent claims 1, 5, 9, 13, and 17. Also, the secondary reference (i.e., Joao) fails to disclose, or even suggest, the deficiencies of the primary reference as discussed above with respect to independent claims 1, 5, 9, 13, and 17. Indeed, the Examiner does not even assert such. Thus, the combination of the secondary reference with the primary reference also fails to disclose, or even suggest, the deficiencies of the primary reference as

discussed above with respect to independent claims 1, 5, 9, 13, and 17. Accordingly, claims 2, 6, 10, 14, and 18 should be allowable over the combination of the secondary reference with the primary reference at least by virtue of their dependency on independent claims 1, 5, 9, 13, and 17. Moreover, claims 2, 6, 10, 14, and 18 recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 2, 6, 10, 14, 17, and 18 be withdrawn.

Conclusion

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.


To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

Hunton & Williams LLP

By:


Dalei Dong
Registration No. 60,363
James R. Miner
Registration No. 40,444

Hunton & Williams LLP
1900 K Street, N.W.
Washington, D.C. 20006-1109
Telephone: (202) 955-1500
Facsimile: (202) 778-2201

Date: June 2, 2008